

REMARKS

Non-elected claims have been cancelled without prejudice, the Applicant reserving the right to file further divisional patent applications. In addition, claims have been amended to define a primary intraocular lens having a slit through an anterior surface with the optic including an optic region overhanging the slit and the anterior surface. No new matter has been added with this amendment inasmuch as these features are shown in the originally submitted drawings and described in the specification on page 16, beginning at line 25.

This structure facilitates an insitu assembly of the primary and secondary lenses which results in facilitating operating procedures and shortening time necessary for the operation which, of course, decreases the possibility of infection.

In specific response to the subject Office Action, the Examiner has objected to this specification as failing to provide proper antecedent basis for the claimed subject matter stating that the terminology "within the slit formed in and through the primary lens optic generally tangential to the enter surface of the set optic".

Inasmuch as this claim language has been removed by the present amendment, no amendment to this specification is necessary.

The Examiner has also rejected claims 1, 4-5, 8, and 27-29 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. This rejection is based upon a typographical error, namely "preliminary", should be "primary". Amendment to the claims has been made to overcome this rejection.

Claims 21-26 have been rejected by the Examiner under 35 USC 102(b) as being anticipated by U.S. 6,197,058 B1 to Portney. This rejection is moot in view of the present cancellation of these claims.

Claims 27 and 29 have been rejected by the Examiner under 35 USC 102(b) as being anticipated by U.S. 5,098,444 to Feaster. In this rejection, the Examiner stated that Feaster discloses a primary IOL comprising an optic, peripheral edge, anterior surface (top surface), posterior surface (bottom surface), power, and at least one slit (227) formed in and through the optic adjacent the edge or the optic. The Examiner further states that Feaster discloses the IOL to comprise a dual optic IOL.

The Applicant traverses this rejection on the basis of the Amended claims.

The Applicant submits that anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of the claimed invention. RCA Corp. v. Applied Digital Data Systems, Inc. 221 USPQ 385 (Fed. Cir. 1984); In re Sun 31 USPQ 2d 1451 (CAFC 1993); Advanced Display Systems, Inc. v. Kent State University 540 USPQ 2d 1673 (CAFC 2000).

Further, the Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. Ex Parte Levy 17 USPQ 2d 1461 (USPTO Board of Patent Appeals and Interferences 1990).

In addition, the Applicant submits that anticipation must meet strict standards and unless all of the same elements are found in exactly the same situation and united in the same way to form identical function in a single prior art reference, there is no anticipation. Tights, Inc. v. Acme-McCary Corporation, et al. 191 USPQ 305 (CAFC 1976).

Bearing in mind this criteria, claims 27 and 29, as amended, include a primary intraocular lens having at least one slit formed in and through the primary intraocular lens optic anterior surface adjacent the peripheral edge of the optic without penetration of the posterior surface.

This structure must be contrasted to that taught by Feaster, particularly the slit (227) referred to by the Examiner and most clearly seen in Figure 29 of Feaster. The structure of

the present invention, namely the slit facilitates the assembly of a secondary lens onto the primary lens without access to the posterior side. Thus, the assembly can be accomplished without addressing the posterior side of the primary lens as is necessary in the Feaster reference as is evident from the teachings of Figure 29.

Accordingly, the structure of the present invention is not taught or suggested by Feaster and there is no inherent teaching of such structure in view of the teachings of Feaster. In fact, Feaster teaches away from the present invention due to the fact that access to the posterior side of the primary lens is necessary for the attachment of the secondary lens.

In view of the lack of teaching of this element of the present invention, the Applicant submits that in view of the criteria hereinabove set forth a rejection of amended claims 27 and 29 under 35 USC 102(b) on the basis of the Feaster reference is not sustainable. Accordingly, the Applicant respectfully requests the Examiner to withdraw the rejection of claims 27 and 29 under 35 USC 102(b) on the basis of the Feaster reference.

Claims 1, 8, 27, and 29 have been rejected by the Examiner under 35 USC 102(b) as being anticipated by U.S. 5,968,094 to Werblin, et al.

The Examiner refers to Figures 6-8 and respective proportions of the specification.

Reiterating the criteria hereinabove set forth for finding of anticipation under 35 USC 102(b) the Applicant submits that there is no structure taught or suggested by the Werblin, et al. reference regarding a slit in the anterior surface of the primary intraocular lens along with an optic region overhanging the slit.

This overhanging region function to maintain the secondary intraocular lens tab within the slit and further facilitates assembly of the primary and secondary lenses.

In view of this lack of teaching, the Applicant submits that a rejection of claims 1, 8, 27, and 29 under 35 USC 102(b) is not sustainable and respectfully requests the Examiner to withdraw this rejection based upon the Werblin, et al. references.

Claims 1, 4, 5, 27, and 29 have been rejected by the Examiner under 35 USC 102(b) as being anticipated by U.S. 6,113,633 to Portney. In this rejection, with regards to Claims 1, 4, and 5, the Examiner states that Portney discloses an IOL system comprising a primary IOL having an anterior surface, posterior surface, peripheral edge, power, and a thin slit (opening 34) formed in and through the lens optic generally tangential to the anterior surface of the optic and attachment means affixed to the optic along with a secondary IOL having an optic with an anterior surface, posterior surface, peripheral edge, and an attachment tab.

The '633 reference teaches a primary intraocular lens 11 with a pocket 30 along with openings 34, identified by the Examiner as slits, for insertion of the secondary IOL 32 into the pocket 30.

Assuming arguendo that the opening 34 is a slit, there is no corresponding structure taught equivalent to optic regions overhanging the slit and the anterior surface of the primary intraocular lens. Accordingly, rejection of claims 1, 4, and 5 on the basis of the Portney '633 under 35 USC 102(b) is not sustainable.

With specific reference to claims 27 and 29, rejected under 35 USC 102(b) on the basis of the Portney '633 reference, the same arguments apply. Accordingly, the Applicant respectfully request the Examiner to withdraw the rejection of claims 1, 4, 5, 27, and 29 under 35 USC 102(b) on the basis of the Portney '633 reference.

Claims 1, 4, 8, 27, and 29 have been rejected by the Examiner under 35 USC 102(b) as being anticipated by U.S. 4,842,601 to Smith. In this rejection, the Examiner states that Smith discloses an IOL system 130 referring to Figure 11 which includes a primary IOL 132 having anterior surface (132a + 38b) posterior surface (132b) peripheral edge 38 and a thin slit 40.

The Applicant submits that the Smith reference fails with regard to teaching or suggesting any structure similar to the Applicant's slit with overhanging optic regions and accordingly respectfully request the Examiner to withdraw the rejection of claims 1, 4, 8, 27, and 29 under 35 USC 102(b) on the basis of the Smith reference.

Claims 21-24 and 28 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over U.S. 5,098,444 to Feaster.

Claims 21-24 have been cancelled and in view of the dependency of Claim 28 from Claim 27 it is clear that Feaster provides no teaching or structure on which a prima facie case of obviousness can be established. Accordingly, the Applicant respectfully requests the Examiner to withdraw the rejection of claim 28 under 35 USC 103(a) on the basis of the Feaster reference.

In view of the arguments hereinabove set forth and amendment to the claims it is submitted that each of the claims now in the Application defines patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is aware of the references of record. Reconsideration and allowance are respectfully requested.

Respectfully submitted,



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